

REMARKS

Claims 54-82 are currently pending in the present application.

In the Office communication dated June 14, 2006, the Examiner indicated that the Amendment filed on April 14, 2006, along with a RCE, was non-responsive under MPEP § 821.03 in that the newly presented claims were not readable on the elected invention. Subsequent to the mailing of the Office communication, Applicant held two teleconferences with the Examiner, including on June 27, 2006, during which the Examiner, along with the Supervisory Patent Examiner Christopher Grant, indicated that the RCE could not be used to prosecute non-elected invention. Examiner Grant cited MPEP § 819 as support for this position.

MPEP § 819 states, in part:

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in MPEP § 821.03.

First, Applicant notes that the Examiner in this instance has never issued a restriction requirement, and hence Applicant has never elected an invention. However, to the extent that the Examiner deems the initial presentation of the claims to constitute a constructive election of “a system and method for identifying user preferences and generating a program schedule based on the acquired user preference data and transmitting the redacted program schedule to the user,” Applicant respectfully submit that Section 819 does not prohibit the Examiner to prosecute the newly presented claims. Rather, as stated in Section 819, it is the “general policy” of the Office to

not permit a shift in the invention; this is properly interpreted to mean that the Examiner has discretion to prosecute the newly presented claims. In this instance, given Applicant's good faith attempt in filing the RCE to further prosecute the claims, and given that the fee required for the filing of a RCE is not materially different than the fees otherwise required for the filing of a divisional application, Applicant respectfully submit that it would not be contrary to the letter or spirit of MPEP 819 to further prosecute the claims. Indeed, it would appear inequitable to require the Applicant to pay an additional set of filing fees via the divisional application in order to further prosecute the claims.

Furthermore, as discussed during the June 27, 2006 teleconference, it is questionable whether the newly presented claims are indeed directed to a different invention. For instance, canceled Claim 1 was directed to a system for providing content data to a user, whereby the content data is distributed to the user after the user selects the content via a programming schedule. The newly presented claims, such as Claim 54, for instance, are similarly directed to the distribution of content data via a programming schedule. While Applicant acknowledges that the newly presented claims are of different scope than the canceled claims, Applicant respectfully submits that the newly presented claims are not directed to a different invention as suggested by the Examiner.

In view of the above, Applicant respectfully requests that the Examiner further prosecute Claims 54-82.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.

601542000500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: June 28, 2006

Respectfully submitted,

By 

David T. Yang

Registration No.: 44,415

MORRISON & FOERSTER LLP

555 West Fifth Street

Los Angeles, California 90013-1024

(213) 892-5587